

Remarks

The present application includes claims 1-33. Claims 1-33 are subject to a restriction and/or election requirement by the Examiner. The Examiner has identified 5 inventions in the pending claims, divided as follows (quoting from the Office Action):

- I. Claims 1-11 & 29, drawn to a game in which the player chooses between additional winning outcomes & a feature game not triggered by an outcome in the base game, classified in class 463, subclass 27.
- II. Claims 12-20, drawn to processor chooses additional features based on the amount wagered, classified in class 463, subclass 25.
- III. Claims 21-22, drawn to player may choose to be eligible to be awarded play of the base game at least one of the additional features, classified in class 463, subclass 16.
- IV. Claim 23-28, drawn to a game with a feature outcome that awards a feature, classified in class 463, subclass 20.
- V. Claims 30-33, drawn to a game in which the player chooses between additional winning outcomes & a feature game triggered by an outcome in the base game, classified in class 463, subclass 27.

Within group IV, the Examiner identifies the following species, with claim 23 as a generic claim:

- a. A spinning reel game in which the feature is evaluation of the reels from right to left. (Claim 24)
- b. A game in which the feature outcome comprises substituting at least one symbol in the base game for other symbols. (Claim 25)

c. A game in which the evaluation criteria for the feature outcome is the occurrence of at least one symbol that is not used to define a winning outcome in the base game and the occurrence of at least one symbol in a manner that is not used to define any winning outcome other than the feature outcome. (Claim 26)

d. A game in which the evaluation criteria is the presence of a predetermined number of a certain symbol as a scatter symbol. (Claims 27 & 28)

e. The species are independent or distinct because they are completely different games.

The Examiner submits that the inventions are distinct from each other because Inventions I and V are directed to related games. As stated by the Examiner, the related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). The Examiner asserts that either the bonus game is triggered by an occurrence in the base game or not — it cannot be both at the same time. Furthermore, the Examiner asserts that the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.

The Applicant respectfully disagrees that no overlapping subject matter exists and that there would be a serious burden on the examiner if restriction is not required pursuant to MPEP § 808.02. The Examiner has already searched and opined upon many of these claims

together in previous actions. However, in the interests of advancing prosecution, the Applicant elects to proceed with an election of group 1, which includes claims 1-11 and 29.

Additionally, the Applicant submits that the Examiner's description of group 1 as being "drawn to a game in which the player chooses between additional winning outcomes and a feature game not triggered by an outcome in the base game" is not entirely accurate. Rather, the Applicant submits that claim 1 recites a gaming machine that includes a selector which, when operated, adds a feature to the base game. By operating the selector, the player chooses whether or not to add the additional feature to the base game. The additional feature that is added is either a player favorable variation in the outcomes available for the controller to select, or eligibility for one or more feature games in the event of a feature game trigger occurring during play of the base game, for example.

Thus, by this response, claims 1-11 and 29 have been elected and remaining claims 12-28 and 30-33 have been canceled in view of the Examiner's restriction requirement. The Applicant reserves the right to pursue these canceled claims in divisional applications.

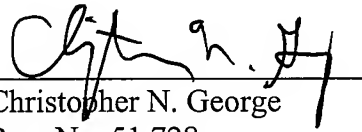
CONCLUSION

It is submitted that the present application is in condition for allowance and a Notice of Allowability is respectfully solicited. If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any additional fees or credit overpayment to the Deposit Account of MHM, Account No. 13-0017.

Respectfully submitted,

Date: July 31, 2007


Christopher N. George
Reg. No. 51,728

McAndrews, Held & Malloy, Ltd.
500 W. Madison Street
34th Floor
Chicago, IL 60661
Phone (312) 775-8000
Fax (312) 775-8100